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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,873	02/07/2005	Volker Stanjek	WAS0681PUSA	4401
22045	7590	10/31/2007		
BROOKS KUSHMAN P.C. 1000 TOWN CENTER TWENTY-SECOND FLOOR SOUTHFIELD, MI 48075			EXAMINER MOORE, MARGARET G	
			ART UNIT 1796	PAPER NUMBER
			MAIL DATE 10/31/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/523,873	Applicant(s) STANJEK ET AL.	
	Examiner Margaret G. Moore	Art Unit 1796	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 October 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): please see attachment.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 26 to 29.
Claim(s) objected to: 15,16,22,23 and 30.
Claim(s) rejected: 11-14,17-21,24,25.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☒ Other: Please see attachment.


Margaret G. Moore
Primary Examiner
Art Unit: 1796

ATTACHMENT:

1. Applicants' amendment has overcome the rejection over Majolo et al. The claims have been amended to exclude hydrogen as a possible R group. This distinguishes the claims from the teachings in Majolo et al. which require hydrolysis of the alkoxysilyl groups. See the bottom of column 13 which teaches "substantially complete hydrolysis". Prior to hydrolysis the alkoxysilane functional polymers in Majolo et al. do not anticipate and/or suggest the instant claims since the claims are drawn to a coating process in which the alkoxysilane functional polymers is specifically applied to the substrate. Majolo et al. convert the alkoxysilane groups to Si-OH group prior to coating and there is nothing in Majolo et al. to lead the skilled artisan to avoid hydrolysis.

2. The objection of claim 30 is maintained, since this claim has not in fact been amended in the manner indicated by applicants in their response.

3. Upon very careful consideration, the Examiner has maintained the rejection over Sakagami et al. For the following reasons, applicants' remarks are not persuasive.

Applicants assert a significant and profound difference between methylene and propylene spaced polymers. In this regard applicants are reminded that reliance on different or unexpected results is not permissible in anticipation rejections. As noted on the bottom of page 2 through page 3 of the office action dated 1/22/07, one part of this rejection is anticipatory. Applicants have not addressed this aspect of the rejection.

Second, in the obviousness aspect of these claims, the Examiner simply cannot accept the excerpt from the specification, the paragraph bridging pages 25 and 26, as providing clear and convincing evidence of unexpected results. This is simply too vague and incomplete to provide adequate evidence. Merely stating that the prepolymers resulted in soft and tacky coatings irrespective of the drying temperature and amounts of catalyst is not sufficient. This raises many questions and fails to provide important information such as the type of catalyst, what amounts were exactly used, how these amounts and types compared to the amounts and types used in the inventive examples,

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whether or not a reactive diluent was used, the amount of prepolymer present in the coating composition and the drying conditions. While the specification states that "irrespective of the drying temperature and the amounts of catalyst used..." the Examiner does not believe that applicants exhausted all possible amounts and/or types of catalysts or all possible drying conditions. One cannot make a side-by-side comparison based on this.

In fact, such a lacking explanation of comparative results is especially troublesome to the Examiner when one considers the fact that Sakagami et al. provide examples in which propylene spaced polymers do result in coating compositions that have a hardness value within the claimed range.

Furthermore, the Examiner notes that the two comparative prepolymers and the inventive prepolymers are quite specific while claim 11 is open to any type of prepolymer having any amount or type of the alkoxysilane functionality within the formula (6) present in any location on the prepolymer backbone.

Finally, with regard to applicants' assertion that they find no enablement in Sakagami, the Examiner does not believe that the preparation of a methylene spaced polymer would be outside the level of skill for the ordinary artisan.